

Serial No.: 10/053,456
Art Unit: 2622

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 22, 2005. Through this response, claims 1 and 5 have been amended to place the determining feature and presenting feature, respectively, in 35 U.S.C. § 112, paragraph 6 format, and claim 25 has been added. It is respectfully submitted that claim 25 is not intended to be construed as having any means plus function or step plus function elements pursuant to 35 U.S.C. § 112, paragraph 6. Reconsideration and allowance of the application and pending claims 1-25 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1-24 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Ikeda et al.* ("*Ikeda*," U.S. Pat. No. 6,297,874). Applicant respectfully traverses this rejection.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Ikeda* reference.

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Independent Claim 1

Claim 1 recites (with emphasis added):

25. An apparatus for capturing digital images, comprising:
an image sensor including a plurality of image capture elements,
each of the image capture elements configured to capture image data;
an input element for communicating print size information to the
apparatus; and
*means for determining which of the plurality of image capture
elements correspond to the print size.*

The Office Action provides, in part, as follows (pages 2-3, section 4):

Regarding claims 1 and 7, Ikeda et al discloses in column 2, lines 43-45, column 1, lines 31-33, and figure 1...Using the broadest reasonable interpretation, the line sensor [12] with a row of photoelectric conversion units would be viewed a plurality of image capture elements. Further, the CPU [1] would be a type of logic, and the connection shown between the various components would be input elements for communicating print sizes.

The Office Action and the cited (and un-cited) *Ikeda* sections fail to disclose at least the above emphasized claim language. The above-cited sections from *Ikeda* provide as follows:

[col. 1, lines 31-33]The line sensor is typically formed of an image accumulation unit, which is a plurality of photo-electric conversion units arranged in a row.

[col. 2, lines 43-45] An image sensor is also provided to receive light that has passed through image regions of the roll film original, and output corresponding image signals.

There is nothing in the above cited sections, figure 1, or the rest of the specification of *Ikeda* that discloses a decision step related to the association between the image capture elements and the print size, such as *means for determining which of the plurality of image capture elements correspond to the print size*. Thus, Applicant respectfully requests that the rejection to independent claim 1 be withdrawn.

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Because independent claim 1 is allowable over *Ikeda*, dependent claims 2-6 are allowable as a matter of law for at least the reason that the dependent claims 2-6 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally, the dependent claims are allowable under separate grounds. For instance, claim 3 provides as follows:

26. The apparatus of claim 1, *wherein a portion of the plurality of image capture elements is used to capture the image data* and only the captured image data is presented to a user.

Nothing in *Ikeda* discloses that anything less than all of the photo-electric conversion units (assuming *arguendo* that the photo-electric conversion units are equated to the image capture elements) are used in the image capture process. Thus, Applicant respectfully requests that the rejection to dependent claim 3 be withdrawn.

Independent Claim 7

Claim 7 recites (with emphasis added):

27. A method for adapting a print size to a captured image in a digital image capture device, the method comprising the steps of:
providing an image sensor including a plurality of image capture elements;
determining the elements of the image sensor that correspond to a selected print size; and
presenting image sensor data corresponding to the selected print size to a user of the image capture device.

For reasons similar to those described above in association with independent claim 1, Applicant respectfully submits that *Ikeda* does not disclose at least the above-emphasized claim features. Thus, Applicant respectfully requests that the rejection to independent claim 7 be withdrawn.

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Because independent claim 7 is allowable over *Ikeda*, dependent claims 8-15 are allowable as a matter of law.

Additionally, the dependent claims are allowable under separate grounds. For instance, claim 9 provides as follows:

28. The method of claim 7, further comprising the step of *capturing image sensor data using only those image capture elements corresponding to the selected print size*.

Nothing in *Ikeda* discloses that anything less than all of the photo-electric conversion units (assuming *arguendo* that the photo-electric conversion units are equated to the image capture elements) are used in the image capture process. Thus, Applicant respectfully requests that the rejection to dependent claim 9 be withdrawn.

Independent Claim 16

Claim 16 recites (with emphasis added):

29. A computer readable medium having a program for adapting a print size to a captured image in a digital image capture device, the program including logic for performing the steps of:

determining the elements of an image sensor that correspond to a selected print size; and

presenting image sensor data corresponding to the selected print size to a user of the image capture device.

For reasons similar to those described above in association with independent claim 1, Applicant respectfully submits that *Ikeda* does not disclose at least the above-emphasized claim features. Thus, Applicant respectfully requests that the rejection to independent claim 16 be withdrawn.

Because independent claim 16 is allowable over *Ikeda*, dependent claims 17-24 are allowable as a matter of law.

Additionally, the dependent claims are allowable under separate grounds. For instance, claim 18 provides as follows:

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30. The program of claim 16, further comprising *logic for performing the step of capturing image sensor data using only those image capture elements associated with the image sensor that correspond to the selected print size.*

Nothing in *Ikeda* discloses that anything less than all of the photo-electric conversion units (assuming *arguendo* that the photo-electric conversion units are equated to the image capture elements) are used in the image capture process. Thus, Applicant respectfully requests that the rejection to dependent claim 18 be withdrawn.

Due to the shortcomings of the *Ikeda* reference described in the foregoing, Applicant respectfully asserts that *Ikeda* does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II. New Claims

As identified above, claim 25 has been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

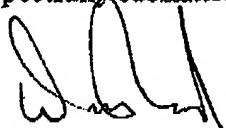
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CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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